

REMARKS/ARGUMENTS

Claims 1-49 were examined. The claims have been amended and canceled as noted above. Reexamination and reconsideration of the claims, as amended, are respectfully requested.

As an initial matter, Applicants have reviewed a copy of the IDS filed on March 18, 2004. Applicants did not prepare or submit this IDS and assume that it was submitted in error by someone unrelated to the Applicant. For that reason, Applicants will not be resubmitting any of the information included on the errant IDS.

Applicants also note the objection to the Declaration. Applicants point out that all inventor addresses and other information was included on the Application Data Sheet (ADS). Under such circumstances, it is not necessary to include the address or other detailed inventor information on the Declaration itself.

Applicants note the provisional double patenting rejection over copending Application No. 10/306,813. Applicants have submitted an appropriate Terminal Disclaimer.

Claims 20-49 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. The Examiner argues that the method claims omit "essential steps," noting that, for example, claims 20-44 should recite "providing adjusting means and releasing means for adjusting the length and releasing a deployable portion." Similar recitation of structure is required for each of independent claims 45-49 (which have now been canceled).

Such indefiniteness rejection of claims 20-44 is respectfully traversed. While MPEP § 2172.01 does require that essential matter be in claims, nowhere does it state or suggest that method claims require structure as the Examiner is now requiring for all the method claims herein. More importantly, Examiner's requirement of providing structural limitations within the method steps of claims 20-49 is contrary to the statutory language in 35 U.S.C. 112, paragraph 6, which states that "an element in a claim for a combination may be expressed as a means **or step** for performing a specified function without the recital of structure, material, or acts in support thereof . . ." It is well settled in patent law that method claims, such as those stated herein, do

not necessarily require the recitation of structure. Moreover, it is pointed out that method claim 20 herein does recite structure, such as a catheter and a stenting structure.

For these reasons, it is respectfully requested that the rejection for indefiniteness be withdrawn.

All claims herein have been rejected as being anticipated by or obvious over U.S. Patent No. 6,129,756 to Kugler et al optionally in combination with U.S. Patent No. 6,383,171 to Gifford et al. Without conceding the correctness of such objections, they have been overcome as follows.

Independent apparatus claim 1 has been amended to more specifically recite that the deployment mechanism is adapted to "apply a radially outward force along a selectable length" of the stenting structure "to deploy a portion of the stenting structure having said length" which is released into the vessel. The disclosure of the Kugler et al. patent is limited to the release of self-expanding aneurysmal grafts into an abdominal aneurysm. Nowhere does Kugler teach or suggest applying a radially outward force in order to expand the stent structure, much less that the force be applied along a selected length to deploy only a portion of the structure.

While Applicants recognize that the Examiner argues that "it is well known in the art to have the stents being balloon-expanded, self-expanded, or both self-expanded and balloon-expanded," (Paragraph 12 of the Office Action), the fact that balloon-expandable stents were known does not mean that it would have been obvious to combine them with the aneurysmal graft delivery system of Kugler. Indeed, the deployment of the graft as illustrated in Figs. 15-19 of Kugler would be difficult if not impractical to perform using a balloon in the open space of the abdominal aneurysm.

Furthermore, even if a balloon is somehow combined with the elongate graft and the deployment catheter of Kugler, such a combination would not provide for applying a radially outward force "along a selectable length" of the stenting structure as now required by claim 1.

For these reasons, it is respectfully submitted that independent claim 1 as well as claims 2-12 and 14-17 dependent thereon, are in condition for allowance.

Independent method claim 20 was also rejected as being anticipated by the Kugler et al. patent. Claim 20 has also been amended to more clearly distinguish Kugler. In particular,

claim 20 now recites that the portion of the stenting structure which is to be deployed is uncovered and that the length of the uncovered section is adjusted to be at least equal to the desired length of the stent to be placed. After the uncovered length is adjusted, a radially outward force is applied to the stent structure in order to expand the uncovered portion thereof while the remaining portion remains covered in the catheter.

Kugler teaches only the release of self-expanding graft structures from the distal end of a catheter as the catheter is retracted. There would be no reason or benefit to combining the graft deployment structure of Kugler with an internal balloon or other mechanism for applying a radially outward force to the graft as the cover is being retracted. Indeed, expanding a balloon within the graft structure would likely make retraction of the catheter to progressively release the graft difficult if not impossible.

For these reasons, it is believed that independent claim 20 as well as all claims dependent thereon are now in condition for allowance.

As all other independent claims (45-49) have now been canceled (without prejudice to resiling in a subsequent application), it is believed that all remaining claims are in condition for allowance and requested that the application be passed to issue at an early date.

CONCLUSION

If for any reason the Examiner believes that a telephone conference would in any way expedite prosecution of the subject application, the Examiner is invited to telephone the undersigned at 650-326-2400.

Respectfully submitted,
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Attachments: *Terminal Disclaimer '813*

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